

REMARKS

Claims 1, 2, and 5-20 are pending in the present application.

The rejection of Claims 1-20 under 35 U.S.C. §103(a) over Yip in view of Bender is obviated by amendment.

The present invention provides a process for producing a fresh fish egg product or a milt product, comprising

treating at least one fresh fish egg or milt with an aqueous alkali solution; and

washing off or neutralizing the aqueous alkali solution on the treated at least one fish egg or milt,

wherein said aqueous alkali solution is prepared by dissolving an alkali in water, said alkali is selected from the group consisting of calcium oxide, sodium hydroxide, potassium hydroxide, calcium hydroxide, magnesium carbonate, ammonium carbonate, sodium carbonate, potassium carbonate, calcium carbonate, sodium hydrogencarbonate, and potassium hydrogencarbonate (see Claim 1). Applicants submit that the combined disclosures of Yip and Bender cannot affect the patentability of the claimed invention for the following reasons.

In regard to Yip, Applicants note that this is deficient for at least two reasons. First, as recognized by the Examiner, Yip fails to disclose or suggest washing off or neutralizing the aqueous alkali solution on the treated at least one fish egg or milt. Second, Yip does not disclose or suggest treating fish roe with the alkali recited in Claim 1. At best, Yip provides alkali metal sulfites and citrates, which are not present in the claimed invention. Therefore, based on the disclosure of Yip, the skilled artisan would not have any expectation that

treating fish roe with the alkali recited in Claim 1 provide enhanced commercial value to ovaries or eggs of salmon and the like caught at a later time (see page 4, lines 7-10).

At least in an attempt to compensate for the first deficiency in the disclosure of Yip, the Examiner cites Bender. However, Bender fails to compensate for this deficiency since this reference merely relates to the treatment of fish, not to eggs or milt (i.e., internal organs). For example, Bender discloses that fish are treated after the fish are eviscerated (see column 3, lines 40-49; column 4, lines 4-6; and column 4, lines 65-68). At no point does Bender disclose or suggest that the internal organs are treated.

Further, Bender discloses that among the various phosphates, some specific orthophosphates are useful for retarding bacterial contamination on fish meat. However, Bender does not disclose or suggest the use of the specifically claimed alkali solution as presently claimed. Accordingly, even if the

Applicants remind the Examiner that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art *also suggests the desirability of the combination* (MPEP §2143.01). In this case, no such motivation can be found in either Yip or Bender. Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation... to modify the reference... Second, there must be a reasonable expectation of success. Finally, the prior art reference... must teach or suggest all the claim limitations.” (MPEP §2142) For the reasons set forth above, the even if the artisan were to combine the disclosures of Yip and Bender the skilled artisan would have no reasonable expectation of the advantages flowing from the claimed invention. And, as noted above, the combined disclosures would still fail to disclose or suggest washing off or neutralizing the aqueous alkali solution on the treated at least one fish egg or milt, as well as the specific identity of the alkali solution.

In view of the foregoing, Applicants request withdrawal of this ground of rejection.

Applicants submit that the present application is in condition for allowance. Early notification to this effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/03)
NFO/VKS